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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,073	11/25/2003	James V. Leonard	BOEI-I-1205	4169
60483	7590	05/19/2006	EXAMINER	
LEE & HAYES, PLLC 421 W. RIVERSIDE AVE. SUITE 500 SPOKANE, WA 99201				AHLUWALIA, NAVNEET K
		ART UNIT		PAPER NUMBER
		2166		

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/722,073	LEONARD ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Navneet K. Ahluwalia	2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 25 November 2003.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-21 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 25 November 2003 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

### **DETAILED ACTION**

1. The application has been examined. Claims 1 – 21 are pending in this office action.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 14 recites the limitation "the method of claim 11" in line 1. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 8 – 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 8 – 13 are directed to a computer software program, which is, program pro se and is not one of the statutory subject matter.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 – 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Giuffrida et al. ('Giuffrida' herein after) (US 2003/0028503 A1).

With respect to claim 1,

Giuffrida discloses a method for augmenting an internal library with published submissions to a technical society, the method comprising:

- locating an abstract for a published submission on a technical society website (paragraph 0002 lines 12 – 14);
- downloading the abstract for the published submission to a machine-readable memory medium at a first address (paragraph 0002 lines 12 – 14);
- locating the published submission on a technical society website (paragraph 0002 lines 12 – 14);
- downloading the published submission to the machine-readable memory medium at a second address (paragraph 0002 lines 12 – 14); and
- embedding a hyperlink to the second address into the abstract, the hyperlink being configured to display the published submission when invoked (paragraph 0002).

With respect to claim 2,

Giuffrida discloses the method of claim 1, wherein locating the abstract is based upon a submission approval procedure internal to an organization (it is inherent that if the abstract and documents are found in the digital libraries, they would have been submitted at a certain point in time to an organization, paragraph 0002 and Figure 3).

With respect to claim 3,

Giuffrida discloses the method of claim 2, wherein locating the submission is based upon a submission approval procedure internal to an organization (it is inherent that if the documents are found in the digital libraries, they would have been submitted at a certain point in time to an organization, paragraph 0002 and Figure 3).

With respect to claim 4,

Giuffrida discloses the method of claim 1, wherein the downloading of the abstract includes indexing the first address to allow searching for the abstract (paragraph 0003 and 0009).

With respect to claim 5,

Giuffrida discloses the method of claim 4, wherein the searching is by keyword (keyword is contained in the metadata, paragraph 0005 and 0009).

With respect to claim 6,

Giuffrida discloses the method of claim 4, wherein the searching is by subject (subject is contained in the metadata, paragraph 0005 and 0009).

With respect to claim 7,

Giuffrida discloses the method of claim 4, wherein the searching is by author (author is contained in the metadata, paragraph 0005 and 0009).

With respect to claim 8,

Giuffrida discloses a computer software program for augmenting an internal library with published submissions to a technical society, the computer software program stored on a machine-readable memory medium and comprising:

- a first software component for locating an abstract for a published submission on a technical society website (paragraph 0002 lines 12 – 14);
- a second software component for downloading the abstract for the published submission to the machine-readable memory medium at a first address;
- a third software component for locating the published submission on a technical society website (paragraph 0002 lines 12 – 14);
- a fourth software component for downloading the published submission to the machine-readable memory medium at a second address (paragraph 0002 lines 12 – 14); and

- a fifth software component for embedding a hyperlink to the second address into the abstract, the hyperlink being configured to display the published submission when invoked (paragraph 0002).

With respect to claim 9,

Giuffrida discloses the computer software program of claim 8, wherein locating the abstract is based upon a submission approval procedure internal to an organization (it is inherent that if the abstract and documents are found in the digital libraries, they would have been submitted at a certain point in time to an organization, paragraph 0002 and Figure 3).

With respect to claim 10,

Giuffrida discloses the computer software program of claim 9, wherein locating the submission is based upon a submission approval procedure internal to an organization (it is inherent that if the documents are found in the digital libraries, they would have been submitted at a certain point in time to an organization, paragraph 0002 and Figure 3).

With respect to claim 11,

Giuffrida discloses the computer software program of claim 8, wherein the downloading of the abstract includes indexing the first address to allow searching for the abstract (paragraph 0003 and 0009).

With respect to claim 12,

Giuffrida discloses the computer software program of claim 11, wherein the searching is by keyword (keyword is contained in the metadata, paragraph 0005 and 0009).

With respect to claim 13,

Giuffrida discloses the computer software program of claim 11, wherein the searching is by subject (subject is contained in the metadata, paragraph 0005 and 0009).

With respect to claim 14,

Giuffrida discloses the method of claim 11, wherein the searching is by author (author is contained in the metadata, paragraph 0005 and 0009).

With respect to claim 15,

Giuffrida discloses a system for augmenting an internal library with published submissions to a technical society, the method comprising:

- a first means for locating an abstract for a published submission on a technical society website (paragraph 0002 lines 12 – 14);

- a second means for downloading the abstract for the published submission to a machine-readable memory medium at a first address (paragraph 0002 lines 12 – 14);
- a third means for locating the published submission on a technical society website (paragraph 0002 lines 12 – 14);
- a fourth means for downloading the published submission to the machine-readable memory medium at a second address (paragraph 0002 lines 12 – 14); and
- a fifth means for embedding a hyperlink to the second address into the abstract, the hyperlink being configured to display the published submission when invoked (paragraph 0002).

With respect to claim 16,

Giuffrida discloses the system of claim 15, wherein locating the abstract is based upon a submission approval procedure internal to an organization (it is inherent that if the abstract and documents are found in the digital libraries, they would have been submitted at a certain point in time to an organization, paragraph 0002 and Figure 3).

With respect to claim 17,

Giuffrida discloses the system of claim 16, wherein locating the submission is based upon a submission approval procedure internal to an organization (it is inherent that if the documents are found in the digital libraries, they would have been submitted

at a certain point in time to an organization, paragraph 0002 and Figure 3).

With respect to claim 18,

Giuffrida discloses the system of claim 15, wherein the downloading of the abstract includes indexing the first address to allow searching for the abstract (paragraph 0003 and 0009).

With respect to claim 19,

Giuffrida discloses the system of claim 18, wherein the searching is by keyword (keyword is contained in the metadata, paragraph 0005 and 0009).

With respect to claim 20,

Giuffrida discloses the system of claim 18, wherein the searching is by subject (subject is contained in the metadata, paragraph 0005 and 0009).

With respect to claim 21,

Giuffrida discloses the system of claim 18, wherein the searching is by author (author is contained in the metadata, paragraph 0005 and 0009).

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Navneet K. Ahluwalia whose telephone number is 571-272-5636. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam T. Hosain can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Navneet*

Navneet K. Ahluwalia  
Examiner  
Art Unit 2166



MOHAMMAD ALI  
PRIMARY EXAMINER

Dated: 05/12/2006